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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,958	07/07/2003	Elizabeth M. Pierotti	GGP-03-001US	4742

7590 04/19/2004

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EXAMINER	
DANG, HUNG XUAN	

ART UNIT	PAPER NUMBER
2873	

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Offic Action Summary	Applicati n N .	Applicant(s)	
	10/612,958	PIEROTTI, ELIZABETH M.	
	Examiner	Art Unit	
	Hung X Dang	2873	

-- The MAILING DATE f this communicati n appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-34 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-34 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Information Disclosure Stat ment

1. If applicant is aware of any relevant prior art, he/she requested to cite it on form **PTO-1449** in accordance with the guidelines set forth in M.P.E.P. 609.

Claim Objection

2. Claim 21 is objected to because of the following informalities: "about 20-27 27 mm" should be changed to –about 20-27 mm--. Appropriate correction is required.

Claims Rejection, Double Patenting 101

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 6-13 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-8 of prior U.S. Patent No. 6,588,899. This is a double patenting rejection.

Claims R jection, Obviousness Doubl Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 2, 5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,588,899 (Pierotti). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 2 of patent 6,588,899 claiming a pair of radically-shaped see through lenses having a substantially constant thickness

and substantially constant radius of curvature of between 20-27 mm with respect to at least one axis of the lens; and means for retaining the pair of lenses in a fixed position relative to a wearer, whereby the lenses provide a filed of view with no discernable peripheral distortion. Therefore the claims 1,2 and 5 of this application anticipated by claims 1 and 2 of patent 6,588,899.

6. Claims 3 and 4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6,588,899 (Pierotti).

(Pierotti) do not explicitly state the percentage of the lens used for view as claimed in claims 3 and 4 of this application.

Note that, although the claims 1 and 2 of U.S. Patent No. 6,588,899 **(Pierotti)** do not explicitly state the percentage of the lens used for view as that claimed by claims 3 and 4 of this application. However, it is interpreted by the examiner that the radically-shaped lenses are curve lenses therefore the field of view of the radically-shaped lenses are meet with the percentage of the field of view of claims 3 and 4, it is inherently that the radically-shaped lenses of the claims 1 and 2 of U.S. Patent No. 6,588,899 **(Pierotti)** having the percentage of the field of view of claims 3 and 4 as claimed by applicant. Furthermore, when the office has reasons to believed that an element of a reference is inherent it can make this allegation and call upon applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied upon. (See In re Lucltke and Sloan 169 USPQ 563)

7. Claims 14-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,588,899 **(Pierotti)** in view of claims 13-15 of U.S. Patent No. 6,343,860 **(Pierotti)**.

Claims 1-8 of the U.S. patent No. 6,588,899 **(Pierotti)** are directed to a pair of radically-shaped see through lenses having a substantially constant thickness and substantially constant radius of curvature of between 20-27 mm with respect to at least one axis of the lens; and means for retaining the pair of lenses in a fixed position relative to a wearer, whereby the lenses provide a filed of view with no discernable peripheral distortion.

Claims 1-8 of the patent No. 6,588,899 fails to claim a separate flange member surrounding and integrally attached to each of the lenses; a frame surrounding each of the flange members, with each of the flange members releasably attached to the frame.

Claims 13-15 of the patent No. 6,343,860 (Pierotti) claiming a separate flange member surrounding and integrally attached to each of the lenses; a frame surrounding each of the flange members, with each of the flange members releasably attached to the frame.

Because Claims 1-8 of the patent No. 6,588,899 and Claims 13-15 of the patent No. 6,343,860 are both from the same field of endeavor, the purpose of connecting the lenses to the eyeglasses frame as disclosed by Claims 13-15 of the patent No. 6,343,860 would have been recognized as an art pertinent art of Claims 1-8 of the patent No. 6,588,899.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the eyeglasses frame, such as the one disclosed by Claims 1-8 of the patent No. 6,588,899, with a separate flange member surrounding and integrally attached to each of the lenses; a frame surrounding each of the flange members, with each of the flange members releasably attached to the frame, such as disclosed by Claims 13-15 of the patent No. 6,343,860 for the purpose of connecting the lenses to the eyeglasses frame.

8. Claims 21-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-18 of U.S. Patent No. 6,343,860 **(Pierotti).** Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of both application and the patent are directed to lens element adapted for mounting in eyewear, the lens element having a zero through power and having at least one spherical surface with a radius of curvature in the range of about 20-27mm, the lens element being adapted for positioning such that a center of curvature of the lens element is located at the centroid of rotation of the eye.

Claims 16-18 of U.S. Patent No. 6,343,860 **(Pierotti)** do not explicitly state that the lens element is sufficiently large to provide a field of view greater than 80 degree as claimed in claims 21-26 of this application.

Note that, although the claims 16-18 of U.S. Patent No. 6,343,860 **(Pierotti)** do not explicitly state that the lens element is sufficiently large to provide a field of view

greater than 80 degree. However, it is interpreted by the examiner that the toric-shaped lenses are curve lenses therefore the field of view of the toric-shaped lenses are greater than 80 degree, it is inherently that the toric-shaped lenses of the Claims 16-18 of U.S. Patent No. 6,343,860 **(Pierotti)** having the field of view grater than 80 degree. Furthermore, when the office has reasons to believed that an element of a reference is inherent it can make this allegation and call upon applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied upon. (See In re Lucltke and Sloan 169 USPQ 563)

9. Claims 27-34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-23 of U.S. Patent No. 6,343,860 **(Pierotti).** Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of both application and the patent are directed to a spectacle frame suitable for use with a series of zero-power lenses, each of the lenses having a radius or curvature R between 20 and 27 mm, each lens having the same value of R, the frame supporting left and right lenses in the as worn position so that the centers of the spherical surfaces are located approximately at the centroids of the left and right eyes, respectively, the frame comprising temple pieces and rim portions for engaging the left and right lenses, wherein the rim portion engaging each lens is formed in the shape of a closed curve lying on the surface of a sphere having a radius approximately equal to the radius of the spherical surface.

The difference between the application and the patent is the radius of curvature of the lenses.

The differences are considered obvious design choices and are not patentable unless unobvious or unexpected results are obtained from these changes. It appears that these changes produce no functional differences and therefore would have been obvious.

10. Any inquiry concerning this communication should be directed to Examiner Dang at telephone number (571) 272-2326.

4/04

HUNG DANG

PRIMARY EXAMINER

TC 2800